



Docket No.: 03485/100H799-US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Anand SUBRAMANIAN, et al.

Confirmation No. 4306

Application No.: 10/001,772

Art Unit: 3622

Filed: October 31, 2001

Examiner: Raquel Alvarez

For: INTERNET CONTEXTUAL
ADVERTISEMENT DELIVERY SYSTEM
AND METHOD

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this reply brief in accordance with 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed August 27, 2009.

REMARKS

Claims 15, 16, 21, 22 and 27-89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,076,443 to Emens et al. ("Emens") in view of U.S. Patent No. 5,835,087 to Herz et al. ("Herz").

In her Answer, the Examiner sets forth those elements of claim 15 which she finds to be disclosed in Emens. Conspicuously, she fails to recite from the preamble that the claim is directed to a "system delivering ads to a user *viewing content* operating a station..." This is because, as

described in detail in Appellants' Brief (for example, at page 7, line 8 through page 10, line 2), the Emens system is *incapable of displaying an advertisement and content at the same time*.

Similarly the Examiner asserts that Emens discloses "a match maker that accesses the content retrieved by the user." However, claim 15 calls for "a match maker *configured to, in response to the submission of a URL by the user at the operating station*, access [] the content retrieved by the user." The Examiner acknowledges that Emens does *not* teach accessing content in response to the submission by the user of a URL, but suggests that this feature is taught by Herz.

Appellants disagree. As described in Appellants' brief (for example, at page 10, lines 13 – 18) , Herz does *not* explicitly teach a user retrieving content by submitting a URL. Moreover, even assuming *arguendo* that the news program login process that is disclosed by Herz could be reasonably equated to submitting a URL, Appellants submit that there is little reason to combine these two references in the manner that the Examiner suggests.

The Examiner asserts that the combination is suggested by the advantage of "[avoiding] **unwanted articles in an irrelevant or unexpected context**" (original emphasis maintained). Appellants respectfully disagree. By modifying Emens with the addition of Herz to eliminate the keyword searching of Emens in favor of the user profile-based searching taught by Herz, Appellants submit that it becomes *more likely* that unwanted articles will be retrieved, either because the user profile has not been adequately maintained (and therefore, is *not current*) or because the user's immediate interest is not related to his or her current profile (for example, a completely *new* interest). Significantly, Emens teaches away from the approach of Herz in favor of keyword searching in order to overcome these problems. *See*, for example, Col. 1: 40 – 54 of Emens. It is of course improper to combine references where the references teach away from their combination. *See* MPEP § 2145(X)(D)(2), citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

In her Answer, the Examiner maintains her ongoing contention that Emens discloses a system in which "the search result item is displayed along with the matching product icon." The

Examiner relies on Col. 7: 11 – 17 of Emens to support this position. Col. 7: 11 – 17 of Emens discloses that a request server 160 builds a search results page that displays a product icon for each search result item flagged as having at least one product match. The Examiner asserts that the “product icon is a targeted advertisement based on the search result.” *See* Examiner’s Answer, **Response to Argument**, page 5. Appellants respectfully disagree.

Emens neither discloses nor suggests that the product icon is a targeted advertisement. In fact, there is no indication in Emens that the product icon even specifically identifies a particular product. Rather, it merely provides a link for retrieving product information (for example, advertisements). Further, Emens fails to disclose or suggest that retrieved product information (the targeted ad) is provided to the user in such manner that it is displayed *together* with the content (the search results). Rather, Emens specifically discloses that *either* the requested information *or* the product ad information is shown. *See*, for example, the directed arrow from Request Server 160 to Browser 100 in FIG. 3 of Emens. Emens also makes it clear that a product ad will only be shown *if the user specifically asks for it*:

The search engine then returns a specific search result set showing items which may contain the sought after information. For each search result item, a graphical user interface (GUI) selection is presented, **allowing the user to select the GUI, on demand if so desired, to investigate related advertisement.**

(Col. 4: 65 - Col. 5: line 3 of Emens, emphasis added).

Simply stated, a GUI selection (“product icon”) is *not* an ad. *See*, for example, page 8, line 7 through page 9, line 12 of Appellants’ brief. In Emens, the only way to retrieve an ad is for the user to *click on the product icon after it has been delivered* with the search results. Thus, in contrast to Appellants’ claim 15, the system of Emens fails to deliver an ad for display with user-viewed content *in response to* the submission of a URL for the content by the user.

The Examiner contends that the above arguments are not persuasive, because the “format” of the ads is not claimed. *See* Examiner’s Answer, **Response to Argument**, page 5. Appellants submit that their argument is not based on format. Rather, Appellants maintain that the product icon that is delivered by Emens’ system is just that (an icon), and not an ad.

The Examiner also contends that Appellants have attempted to show non-obviousness by attacking the references individually. Appellants respectfully disagree. To show the erroneous combination being proffered by the Examiner, the Appellants have described what is disclosed by the Emens and Herz references. However, Appellants repeatedly state that it is Emens and Herz in combination that fails to disclose, or suggest, the claimed invention.

Independent method claim 21 and independent system claim 89 recite similar subject matter to claim 15. Appellants therefore submit that the above remarks made in the context of independent claim 15 are also applicable to independent claims 21 and 89.

With reference to dependent claim 36, the Examiner acknowledges that Emens and Herz do *not* disclose that “content is classified by past consumption by users as a consequence of ads that were received and responded to by them.” See Examiner’s Answer, **Response to Argument**, page 6. However, the Examiner states that this feature is “old and well known in the computer related arts,” and claim 36 is obvious in view of Emens, Herz and the Examiner’s personal “official notice.” The Examiner submits that Appellants’ present challenge to the official notice is improper because it fails to “cast reasonable doubt on the fact taken notice of.” See Examiner’s Answer, **Response to Argument**, page 7.

Appellants note that, where official notice is taken of a fact that the Examiner asserts to be “common knowledge,” specific factual findings must be provided by the Examiner in support of the Examiner’s conclusions (for example, in the present case, findings showing some other similar and earlier use of ad content classification on the basis of user reception). See MPEP § 2144.03(B). Believing that this basis had not been provided, Appellants first submitted a request in an Amendment of April 11, 2007 for the Examiner to provide affidavits pursuant to 37 C.F.R. §1.104(d)(2) in support of the Examiner’s conclusions. As acknowledged in Appellants’ brief, the Examiner has not yet provided any such support.

In summary, and contrary to the position taken by the Examiner’s Answer, Appellants submit that their Third Brief on Appeal, filed on August 5, 2009, fully addresses all of the grounds for rejection, and respectfully draws the Board’s attention to that document for a full analysis of the errors in the Examiner’s rejection.

CONCLUSION

For the reasons set forth above and detailed in Appellants' Second Brief on Appeal, the rejections of claims 15, 16, 21, 22 and 27-89 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the 35 U.S.C. § 103(a) rejections, and pass the case to allowance.

Favorable consideration of this Reply Brief is respectfully requested.

If any fees or charges are required in connection with the above-identified matter, authorization is hereby provided to charge our U.S. Patent and Trademark Office Deposit Account No. 04-0100.

Dated: October 2, 2009

Respectfully submitted,

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